

## **REMARKS**

### **I. Summary**

Claims 1-22 are pending. Claims 1, 8, and 9 stand allowed. Claims 2-7, and 10-22 stand rejected.

With entry of the above amendments, Applicants have cancelled claims 3 and 4. Applicants have amended claims 2, 5-7, and 10-22. Support for the amendments to the claims can be located in the specification as follows. Support for the amendments to claims 2, 5, and 17 can be found at least at page 13, lines 16-27 and page 17, lines 6-28. Support for the amendments to claims 6, 7, 10-13, 15, and 16 can be found at least in the claims as originally filed. Support for claim 18 can be located at least at page 11, lines 14 to page 12, line 6 and in the material related to Figure 5. Support for the amendment to claim 19 can be found, for example, at page 24, lines 1-10. Support for the amendment to claim 20 can be found at least at page 13, lines 6-15 and page 23, lines 7-27. Support for the amendments to claims 14 and 21-22 can be found at least at page 25, line 11 to page 28, line 6. Applicants have amended the claims without prejudice to or disclaimer of the cancelled subject matter. Applicants retain the right to file a continuation and/or divisional application on the subject matter cancelled by way of the amendment.

Applicants have introduced new claims 23-25. Support for new claims 23-25 can be found at least in the original claims and at least at page 13, lines 16-27; page 17, lines 6-28, and pages 21-23.

Applicants do not believe any prohibited new matter is introduced by entry of the above amendments and entry is respectfully requested.

### **II. Information Disclosure Statement**

The Examiner asserts that the Information Disclosure Statement filed June 28, 2004, fails to comply with 37 C.F.R. §1.98(a)(2) for failure to provide copies of the indicated references.

Applicants note that the references were cited in the Search Report which issued in the parent PCT application. This application was filed under 35 U.S.C. § 371. Accordingly, under M.P.E.P. § 1893.03(g), we are providing copies of the references cited in the Search Report and a new PTO-1449 form for the convenience of the Office. Applicants respectfully request an acknowledged PTO-1449 form at the Examiner's convenience. Applicants do not

believe that the requirements under 37 C.F.R. §§ 1.97 and 1.98 apply given the Notice of Acceptance of the application under 35 U.S.C. § 371 has been received.

### **III. Claim Objections**

Claims 3-4 are objected to under 37 C.F.R. § 1.75(c) as being of improper dependent form for failing to further limit the subject matter of a previous claims. The Office objects to the claims because allegedly “it is of no patentable import as where the compound to be used in the composition is obtained from, and one of skill in the art would understand that 2-O-(β-D-glycopyranosyl) ascorbic acid derived from one plant is the same as 2-O-(β-D-glycopyranosyl) ascorbic acid derived from another plant”.

Without acquiescing as to the merits of the objection, Applicants have cancelled claims 3-4, thereby mooting the objection. Applicants respectfully request withdrawal of the objection.

The Office also objected to claim 2 in view of claim 14 under 37 C.F.R. § 1.75 as being a substantial duplicate. Applicants have amended claim 2 to be directed to a “provitamin C extract...from...a plant of *Lycium chinense*...” Claim 14 is directed to a provitamin C composition containing the recited ascorbic acid and a pharmaceutically acceptable, cosmetically acceptable, or dietarily acceptable component. In view of the amendments, the objection to claim 2 appears to have been mooted and should respectfully be withdrawn.

The Office also objected to claim 2 in view of claims 18-20 and 22 as being substantial duplicates under 37 C.F.R. § 1.75. Claim 2, as amended, is directed to a “provitamin C extract” as discussed above. Claims 18-20 are amended and are method of use claims and not composition claims. Accordingly, they are directed to separate subject matter, and the objection should respectfully be withdrawn.

### **IV. Rejections Under 35 U.S.C. § 112, Second Paragraph**

Claims 2-7, 10-15, and 18-22 stand rejected under 35 U.S.C. § 112, second paragraph as indefinite.

#### **Claim 2**

Claim 2 stands rejected as being drawn to a composition, but the claim is silent as to what other compound is present. Applicants have amended the claim to recite a “provitamin

C extract.” In view of the amendment to the claim, Applicants respectfully assert that the rejection is mooted and should be withdrawn.

**Claims 5-7**

Claim 5 is alleged to be indefinite for not reciting any methodological steps. Claims 6-7 depend from claim 5 and also fail to recite methodological steps and are likewise rejected.

Applicants have amended the claim to affirmatively recite steps that are part of a method of producing a 2-O-( $\beta$ -D-glucopyranosyl) ascorbic acid. Accordingly, in view of the amendments to claims 5-7, Applicants respectfully request withdrawal of the rejection.

**Claims 10-13**

Claims 10-13 stand rejected as a method of producing 2-O-( $\beta$ -D-glucopyranosyl) ascorbic acid, wherein the method does not recite any methodological steps of the process. Claims 10-13 have been amended to either affirmatively recite steps, or to recite compounds within the steps, thereby obviating the indefiniteness rejection.

**V. Rejections Under 35 U.S.C. § 102**

**Yagi**

Claims 2-4, 14, and 18-22 stand rejected under 35 U.S.C. § 102(b) as allegedly anticipated by Yagi et al. (EP 0 919 218 A1). Yagi is cited for allegedly disclosing compositions comprising extracts of *Solanaceae* which are used for the same purpose as the compositions as claimed. The Office asserts that the source of the active agent and the intended use of the active agent have no patentable import to the compositions claimed.

Without acquiescing as to the merits of the rejection, claims 3-4 have been cancelled. Accordingly, the rejection in view of Yagi et al. should be withdrawn for these claims.

Without acquiescing as to the merits of the rejection of claim 2 in view of Yagi, Applicants have amended claim 2 to recite a “provitamin C extract from the fresh or dried fruit of a plant of *Lycium chinense*.” Yagi does not describe a provitamin C extract from *Lycium chinense*. As Yagi does not suggest or teach the claimed invention, the rejection should respectfully be withdrawn.

Claim 14 stands rejected in view of Yagi. Claim 14 is directed to a provitamin C composition comprising 2-O-( $\beta$ -D-glucopyranosyl) ascorbic acid and a pharmaceutically,

cosmetically, or dietarily acceptable component. Applicants note that 2-O-( $\beta$ -D-glucopyranosyl) ascorbic acid is novel as claim 1 has been declared allowable. Accordingly, Applicants assert that the rejection should be withdrawn and the claim allowed.

Claims 18-20 stand rejected as anticipated by Yagi. Applicants have amended claims 18-20 to be method claims wherein a compound is administered to the skin of a subject in need of ultraviolet damage protection (claim 18), skin whitening (claim 19), and prevention of wrinkling or sagging (claim 20). The compound is claimed in claim 1 and is novel. Accordingly, its use in claims 18-20 is also novel, and the rejection should respectfully be withdrawn.

Claim 21 has been amended to recite a "pharmaceutical or cosmetic composition comprising the 2-O-( $\beta$ -D-glucopyranosyl) ascorbic acid or a biologically acceptable salt or ester thereof of claim 1 and a pharmaceutically or cosmetically acceptable carrier." Given that claim 1 is allowable, claim 21 should similarly be allowable and novel over Yagi.

Claim 22 has been amended to recite a "pharmaceutical or cosmetic composition comprising the extract of claim 2 and a pharmaceutically or cosmetically acceptable carrier". Claim 2 is novel for the reasons asserted above. Likewise, a composition comprising said extract would similarly be novel. Accordingly, the rejection in view of Yagi should respectfully be withdrawn.

### Chen

Claims 16-17 stand rejected under 35 U.S.C. § 102(a) as anticipated by Chen (U.S. Patent No. 6,238,672). Chen is alleged to disclose foods which comprise lyceum fruit and cactus fruit. The Office asserts that the food disclosed by Chen must inherently disclose 2-O-( $\beta$ -D-glucopyranosyl) ascorbic acid.

Applicants traverse the rejection. Claim 16 recites the compound of claim 1 regardless of its source. Claim 1 has been indicated to be allowed. Accordingly, Applicants assert that the subject matter of claim 1 has been found allowable. Applicants have amended claim 16 to recite a method, but it still depends from claim 1. Accordingly claim 16 should be found allowable, and the rejection withdrawn.

Claim 17 has been amended to be a method of taking a provitamin C by taking the extract of amended claim 2 or a plant of *Lycium genuse* or the fresh or dried fruit of *Lycium genuse*. The main components of the food products disclosed by Chen are dehydrated cactus fruit juice and dehydrated ginseng berry juice. Chen refers to a lyceum fruit as one of the

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additional ingredients. Chen does not suggest or explicitly disclose an extract from the fresh or dried fruit of *Lycium chinese*. Nor does Chen disclose an extract of a plant of *Lycium genuse*. As Chen does not disclose all the elements of the claim, it cannot anticipate the claim as amended. Accordingly, Applicants respectfully request withdrawal of the rejection.

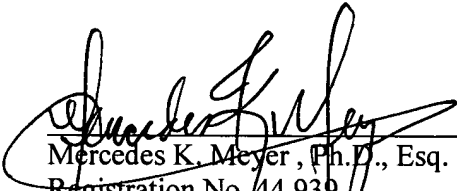
### **CONCLUSION**

In view of the above arguments and amendments to the claims, Applicants respectfully assert that the claims are condition for allowance and respectfully request a Notice of Allowance.

Should any issues remain outstanding or if there are any questions concerning this paper, or the application in general, the Examiner is invited to telephone the undersigned representative at the Examiner's earliest convenience. Should any outstanding fees be owed or overpayments credited, the Commissioner is invited to charge or credit Deposit Account No. 50-0573 accordingly.

Respectfully submitted,

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